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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,767	06/14/2000	Minoru Torii	00862.021926.	8036
5514 7590 01/28/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER DIVECHA, KAMAL B	
			ART UNIT 2151	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/593,767

Applicant(s)

TORII, MINORU

Examiner

KAMAL B. DIVECHA

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-13 are pending in this application.

Claims 14-22 were previously cancelled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 11/5/07 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/5/07 has been entered.

Response to Arguments

Applicant's arguments in the submission filed 11/5/07 with respect to claims above have been considered but are moot in view of the new ground(s) of rejection, as necessitated by the substantial amendments, more specifically, based on the applicant's argument on "prefetch processing".

That is, in response filed, applicant argues in substance that:

- a. Applicant submits that nothing has been found, or pointed out, in Prithviraj that would teach or suggest anything capable of performing prefetch processing for second management information to be displayed as detail information of the network device, as recited in claim 1 (remarks, pg. 14)...Even If combined, therefore, Prithviraj and Scholl would not teach the mentioned features of claim 1.

As indicated in the previous office action, pg. 12-13, Prithviraj substantially discloses all the recited features as in claim 1, except for the fact that Prithviraj teaches dynamically acquiring the data from the network elements based on the user's request and the template, for example: col. 2 L46 to col. 3 L67, fig. 11.

In other words, Prithviraj does not disclose the process wherein the management information of a network device is pre-acquired and/or pre-fetched.

Saksena cures this deficiency. In other words, Saksena discloses Pre-fetching and its importance in a network communication (See the detailed rejection).

Double Patenting

Applicant, in response filed 11/5/07 acknowledged the Double Patenting rejection of claims 1-14 in view of A.N. 11/330,097 (remarks, pg. 9-10).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-32, 22, 24, 26 and 28 co-pending Application No. 11/330,097.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims the claimed subject in both the application is almost similar.

For example:

Claims 1 and 7 of instant application is similar to claim 30 of co-pending application. Note the head portion, body portion and LINKURL are inherent/obvious over the template.

Claims 3-6 are similar to claims 24 and 28. Both set of claims disclose outputting data in html form.

Even though the language of the claim is not similar, both sets of claims disclose SIMILAR INVENTION, i.e. a network management device comprising a web-based management interface for displaying the managed devices and/or information regarding the managed devices of the network, wherein the display includes link information embedded therein which when actuated or selected by the user displays a second display comprising the information of the network device, wherein the display is in html format.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Double Patenting rejection of claims 1-14 in view of USPN 6,308,205 and USPN 7,028,081 B2 is withdrawn in light of the amendments filed 11/5/07 and applicant's response, see remarks, pg. 10-11.

Similarly, the Double Patenting rejection of claims 1-14 in view of USPN 7,028,081 and USPN 6,308,205 is withdrawn, at least for the same reasons as set forth above.

Also note that applicant's arguments (remarks, pg. 11-12) regarding Carcerano and Kawashima as not available as prior art is not persuasive.

Initially, applicant has admitted that both of these references are available as prior art, see response filed 5/16/07, pg. 9. See MPEP § 804 I. B, which discloses instances where double patenting issue can be raised. More specifically, Double Patenting can be raised between an issued patent and a co-pending application.

Claim Rejections - 35 USC § 112

The 35 U.S.C. 112, second paragraph rejection presented in the previous office action is withdrawn due to claim amendments, see response filed 11/5/07.

Claim Objections

Claim 13 is objected to under 37 CFR 1.75(d)(1), as failing to provide a support for the “computer-readable medium”.

The specification refers to term “computer-readable storage medium”, see substitute specification filed 3/3/06, pg. 8 [0046].

Claim 1 recites, “a network device managing apparatus for ...said apparatus comprising...”

In order to present the claim in a clear form, applicant is suggested to clarify “said apparatus” to “said network device managing apparatus”. (similar correction is required in claims 2-13).

Applicant is requested to take appropriate action.

For 35 U.S.C. 101 analysis, the “computer-readable medium” is interpreted as “computer-readable storage medium”, i.e. a physical storage medium storing a computer code.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 recites:

A network device managing apparatus [for...], said apparatus comprising:

- first receiving means...
- transmitting means...
- extracting means...
- specifying means...
- acquiring means...
- second receiving means...
- generating means...
- transferring means...

Initially, the claim fails to fall into any of the four enumerated category of the patentable statutory subject matter as set forth above.

Although the claim recites the term “apparatus”, the claim actually lacks the necessary physical articles/objects/elements/components to constitute an apparatus, a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter.

As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

[Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make the claim statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer”).]

The specification is further evidenced to disclose “the means” to include computer programs, routines, codes, etc., (pg. 24 lines 18-26 of specification as filed, pg. 8 [0046] of substitute spec., filed 3/3/06), thus resulting the claim to be interpreted as software per se.

Claims 2-6 are rejected for the same reasons as set forth above.

Hence, the claim fails to place the claimed invention, more specifically claims 1-6, squarely within one statutory class of invention as set forth above.

Please note, in order to clearly claim a physical apparatus, applicant is suggested to include the physical components/elements/ structure of an apparatus into the claim in a way that would structurally and functionally realize “the means” as in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prithviraj et al. (hereinafter Prithviraj, U. S. Patent No. 5,987,513) in view of Saksena (US 6,055,572).

As per claim 1, Prithviraj discloses a network device managing apparatus for monitoring and managing a network device based on processing first display information of the device and second information linked from the first display information (see Abstract, col. 2 L45 to col. 3 L67), said apparatus comprising:

first receiving means for receiving a request for transmitting the first display information required for displaying first management information of a device (col. 3 L48 to col. 4 L67, col. 14 L42 to col. 5 L56, col. 20 L5 to col. 21 L21: cybercore);

transmitting means for transmitting, by executing a first process (i.e. server process, as per applicant, the first process and second process correspond to WebNetspot, see remarks filed 11/5/07, pg. 9) invoked by the request received by said first receiving means, the first display information (col. 3 L48 to col. 4 L67: transmitting homepage for a network device, col. 20 L5 to col. 21 L21: cybercore);

extracting means for extracting link information embedded in the first display information after said first receiving means receives the request for transmitting the first display

information (fig. 12 item #1230, 1240, 1250, col. 10 L16-65, col. 11 L26 to col. 12 L67, col. 19 L46 to col. 20 L67, col. 23 L54 to col. 24 L64);

specifying means for specifying, by executing the first process (i.e. server process), second management information of the network device by using template data which describe a plurality of pieces of management information required to display the second display information linked from the first display information, wherein the second display information includes the second management information which differ from the first management information included in the first display information of the network device, and the first and second management information are a part of information for indicating details of the network device (col. 11 L25 to col. 12 L67, Appendix I-IX: template describing the data and management information, col. 3 L4-34: home page with hyperlinks for information of interest such as errors, status, etc.);

second receiving means for receiving instruction to be used for displaying information based on the second display information including the second management information, i.e. information corresponding to the link information extracted by said extracting means (fig. 12 item #1230, 1240, 1250, col. 3 L48 to col. 4 L67, col. 10 L17-57 col. 14 L11 to col. 15 L67, col. 23 L54 to col. 24 L64: i.e. user actuating one of the hyperlinks to select the information group of interest);

acquiring means for acquiring, from the network device specified by the link information extracted by said extracting means, by executing the first process, the second management information specified by said specifying means (fig. 12 item #1260, 1270, 1280 and 1290, col. 23 L54 to col. 24 L65: acquiring the data represented by the hypertext links dynamically);

generating means for generating output information corresponding to the second display information to prepare for displaying the acquired second management information in a web page in a predetermined form by using the obtained instruction data (fig. 12 item #1280, col. 23 L54 to col. 24 L65); and

transferring means for transferring, to a predetermined communication link, by executing a second process invoked in accordance with the instruction received by said second receiving means (i.e. a server process or program, external script or snmp agent), the output information generated by said generating means (fig. 12 item #1290, col. 9 L5-65: snmp agent, col. 12 L14-37: generating html documents externally, col. 21 L5-21, col. 23 L40 to col. 24 L65).

However, Prithviraj does not disclose the acquiring means for acquiring management information of the device related to the second display information in accordance with the link information recognized by said recognizing means before second receiving means for receiving instruction to be used for displaying information based on the second display information including the second management information, i.e. information corresponding to the link information acquired by acquired means (i.e. Prithviraj does not disclose the process or apparatus wherein the management information is pre-acquired and/or pre-fetched from the managed devices and may be pre-stored in database such as MIB database, i.e. pre-fetch processing).

Saksena explicitly discloses the process of pre-fetching information corresponding to hypertext links and storing the information in a cache memory (col. 1 L30-49, col. 3 L7-67).

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Prithviraj in view of Saksena in order to acquire the management information of the device related to the second display information in accordance

with the link information before obtaining instruction for displaying the second display information, i.e. in order to provide pre-fetch processing.

One of ordinary skilled in the art would have been motivated because it would have increased the perceived performance (Saksena: col. 1 L30-40, col. 3 L15-40).

As per claim 2, Prithviraj discloses the apparatus wherein the management information is information in an MIB form (Prithviraj, col. 8 L55 to col. 9 L65, col. 15 L10-55).

As per claim 3, Prithviraj discloses the apparatus wherein said generating means generates the output information based on data, which includes an HTML format for defining the predetermined form, and management information item of the device (i.e. generating output information based on HTML template, fig. 11 item #1140, 1150, fig. 12, col. 12 L31 to col. 13 L42, See Appendix I-V).

As per claim 4, Prithviraj discloses the apparatus wherein said generating means generates the output information in an HTML format (fig. 11 #1150, fig. 12 item #1240, col. 23 L54 to col. 24 L64, See Appendix I-V).

As per claim 5, Prithviraj discloses the apparatus comprising means for outputting the output information (such as display or browser, fig. 11, fig. 12, col. 23 L54 to col. 24 L64).

As per claim 6, Prithviraj discloses the apparatus comprising output means for displaying the output information in accordance with a URL (hyperlink is a URL and browser outputs the information based on URL, fig. 11, fig. 12, col. 10 L17-64, col. 23 L54 to col. 24 L64).

As per claims 7-13, they do not teach or further define over the limitations in claims 1-6 (i.e. claims 7-12 discloses similar subject matter as in claims 1-6, but in method form; and claim

13 in a product form). Therefore claims 7-13 are rejected for the same reasons as set forth in claims 1-6.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Land et al., US Patent No. 6,008,805: Method and Apparatus for Providing Multiple Management Interfaces to a Network Device (Similar Problem Solving Area).
- b. Bawden et al., US Patent No. 6,003,077: Computer Network System and Method for Using Domain Name System To Locate MIB Module Specification and web browser for managing SNMP Agents.
- c. Touboul, US Patent No. 6,125,390: Method and Apparatus for Monitoring and Controlling in a Network.
- d. Weber et al., US 6,480,901 B1: System for Monitoring and Managing devices on a network from a management station via a proxy server that provides protocol converter.
- e. Leong et al., US Patent No. 5,996,010: Method of Performing a network management transaction using a web-capable agent.

Conclusion

This Action is made Non-Final.

Examiner's Remarks: The teachings of the prior art should not be restricted and/or limited to the citations by columns and line numbers, as specified in the rejection. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner, in order to move prosecution forward.

In the case of amendments, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and support, for ascertaining the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Kamal Divecha/

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Art Unit 2151.


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